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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,048	01/28/2002	Juerg Muentener	016790-0454	3929

22428 7590 06/03/2004

FOLEY AND LARDNER  
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3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER

NGUYEN, THONG Q

ART UNIT PAPER NUMBER

2872

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/056,048

Applicant(s)

MUENTENER, JUERG

Examiner

Thong Q Nguyen

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-16 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12 and 14-16 is/are allowed.
- 6) ☒ Claim(s) 25-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The present Office action is made in response to the amendment filed on 3/5/2004. It is noted that in the mentioned amendment, applicant has amended claims 1-4, 6-12 and 14-16; canceled claims 13 and 17-24; and added a new set of claims, i.e., claims 25-30, into the present application.
2. A careful review of the newly-added claims has resulted that the device of the newly-added claims is similar in scope to that of the original claims, thus, all pending claims, i.e., 1-12, 14-16 and 25-30 are examined in this Office action.

### ***Drawings***

3. The drawings contain corrections to figures 1-3 and the newly-added figures 4-5 were received on 3/10/2004. These drawings are approved by the Examiner.

### ***Specification***

4. The substitute specification filed on 3/10/2004 has been received and entered into the present application.
5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Objections***

6. Claims 4 and 15 are objected to because of the following informalities. Appropriate correction is required.

a) In claim 4, on lines 16-18, the claim recites the feature thereof "the at least one beam splitter may be used, in one...reflecting out". The use of the term "may be" in the mentioned feature renders the claim unclear because it is unclear whether the component(s)/function(s) appeared after such terms is/are positive component(s)/function(s) of the device claimed or not. Should the terms "may be" (line 17) be changed to —is—to make clear the feature claimed?

b) The objection to claim 15 is similar to that made to claim 4 for the same reason as set forth in element 6(a) above. Should the terms "may be" (line 19) be changed to —is—to make clear the feature claimed?

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 25-26, 28-29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Endou et al (U.S. Patent No. 5,777,783).

Endou et al disclose a microscope having an illuminating system and a photographing system. The microscope as described in columns 6-10 and shown in figures 1-5 comprises a microscope body for supporting a revolver supporting plural objective lens systems wherein a particular objective lens system is selectively inserted into the optical path via an operation of the revolver, an observation system having eyepiece lens system, optics including lens elements,

beam-splitters, mirrors, etc... for the purpose of guiding light from the sample illuminated by an illuminating system to the observation system and/or the photographic system(s). While Endou et al do not clearly state that the microscope body has a recess; however, the basis body inherently has a recess for receiving the mechanism having a carrier (18) for supporting and controlling the set of beam-splitters (16) and has sufficient space for allowing the insertion and the movement of the mechanism. Regarding to the optics, in columns 6-7, for example. Endou et al disclose the use of a mechanism for selectively inserting a particular light intensity beam-splitter into the light path for either reflecting light out of the beam path to an observation system or to a photographic system which is general meaning is a light detecting system. Applicant should note that a reflection of light from the beam splitter to an observation system as disclosed by the system of Endou et al meets the feature relating to the reflection of the beam splitter as recited in the present claim due to the use of the terms "at least" in the mentioned feature.

9. Claim 27 is rejected under 35 U.S.C. 102(b) as being anticipated by Kajitani et al (U.S. Patent No. 4,834,516).

Kajitani et al disclose a microscope having an illuminating system and a photographing system. The microscope as described in columns 3-4 and 7 and shown in figure 1 comprises a microscope body for supporting an objective lens system, an observation system having eyepiece lens system, optics including lens elements, beam-splitters, mirrors, etc... for the purpose of guiding light from

the sample illuminated by an illuminating system to the observation system and/or the photographic system(s). While Kajitani et al do not clearly state that the microscope body has a recess; however, the basis body inherently has a recess for receiving the mechanism © having a carrier for supporting and controlling a beam-splitter system and has sufficient space for allowing the insertion and the movement of the mechanism. Regarding to the optics, in column 7, Kajitani et al disclose the use of a mechanism © for selectively inserting a particular light intensity beam-splitter into the light path for reflecting images from display (51) into an observation system and/or to a photographic system which is general meaning is a light detecting system. Applicant should note that a reflection of light from the beam splitter to an observation system as disclosed by the system of Kajitani et al meets the feature relating to the reflection of the beam splitter as recited in the present claim due to the use of the terms "at least" in the mentioned feature.

***Allowable Subject Matter***

10. Claims 1-12 and 14-16 are allowed over the cited art.

***Conclusion***

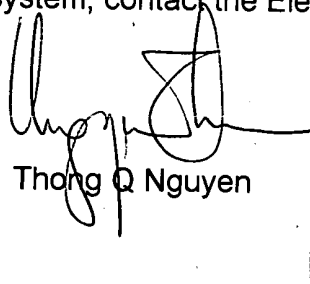
11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Thong Q Nguyen

Application/Control Number: 10/056,048

Art Unit: 2872

Page 7

Primary Examiner  
Art Unit 2872

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